

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/780,646	02/09/01	DORN	H BEIJERSDORF 9

HM12/0830

**EXAMINER**

ROBINSON, A

ART UNIT	PAPER NUMBER
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5616

3  
DATE MAILED: 08/30/01

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/780,646

Applicant(s)

Dorn et al.

Examiner

Allen Robinson

Art Unit

1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 10-15 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 10-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b) Some\* c) None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. 08/440,428.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 (3 sheets)

20)  Other: \_\_\_\_\_

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The preliminary amendment and information disclosure statement filed February 9, 2001 and the declarations by Dr. Hansen and Dr. Dorn filed June 1, 2001 have been entered.

The status of SN: 08/925,372, filed September 8, 2001 should be indicated in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patents 0,285,985 (B') and 0,259,738 (J).

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.The prior art teaches that the claim designated pyridinylmethyl & thiazolylmethyl heterocyclic compounds, analogues, and isomers thereof are known insecticides, effective against insects of the type claimed and may be applied in a non-systemic control method such as dermal application. For example, see the European Patent 0,259,738 reference, page 9, lines 35-42, that states that the novel compounds are used in the field of veterinary medicine to combat a variety of noxious animal-parasitic pest, including fleas and lice; and the European Patent 0,285,985 page 7, wherein fleas may be controlled by dermal application of the active ingredient to domestic animals. Therefore, one skilled in this art would find ample motivation from the prior art supra to use the claimed compounds as insecticides applied non-systemically (dermal application) to humans or animals to combat the target insects of the instant application with a reasonable expectation that said compounds would be safe and effective. Thus, no patentable distinction can be seen between the claims of record and the state of the art as taught by the prior art.

With regard to the declarations by Dr. Dorn and Dr. Hansen said declarations tested compounds that are clearly different from the claim designated compounds. Thus said declaration are not deemed persuasive to over come the above rejection.

References A-I, M-Z, C'-L', N'-Q' and T'-U' are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Robinson whose telephone number is (703) 308-4524.

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AJR  
August 29, 2001

*Allen Johnson*  
Allen Johnson  
PRIMARY EXAMINER  
GROUP 1200